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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/155,843	12/23/1998	SYLVESTRE JOBIC	A32002-PCTUS	9224
21003	7590	10/04/2004	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER

1617

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/155,843	JOBIC, SYLVESTRE	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 17-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 17-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of applicants' remarks and the declaration by Sylvester Jobic submitted June 18, 2004 is acknowledged.

Claim Rejections 35 U.S.C. – 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 17-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over HIRAIWA DAIKU (JP52127936, of record and Derwent publication abstract No. 77-872784, IDS of Jan. 29, 1999, BD) in view of Yoshitomi Pharm. (Derwent publication abstract No. 81-06781D, IDS of Jan. 29, 1999, BE), Yamauchi (JP-0517732), Kodama et al. (WO 95/22902, IDS of Jan. 29, 1999, AB) and Metzner et al. (DE3536417).

3. HIRAIWA DAIKU teaches a wood adhesive composition consisting essentially of a suitable amount of insecticide and an adhesive. The preferred adhesives are thermosetting resins, e.g., phenol resin, and thermoplastic resins, e.g., polyvinyl acetate. The ratio of insecticides to the adhesive is about 1:10 to 1:200. Agents known to be insecticidal may be used as the insecticide. See the abstract. The claims at page 297, and page 298 the right column.

4. HIRAIWA DAIKU does not teach expressly the employment of the specific insecticidal pyrazole compound, e.g., fipronil, and some of the specific adhesive resins, such as ethylene-vinyl-acetate copolymer, phenol-formaldehyde resin and resorcinol-formaldehyde resin, in the composition.

5. However, Kodama et al. teach that pyrazole compounds including fipronil are known to be useful as insecticides. See pages 2-3, particularly, page 2, lines 15-16. The compounds are particularly known to be useful against termites in various wood products such as plywood, particle board and furniture. See, particularly, page 6, lines 4-9. Yoshitomi Pharm teaches that phenol-formaldehyde resin and resorcinol-formaldehyde resin are known to be useful as wood adhesives. See the abstract. Yamauchi teaches that ethylene-vinyl acetate copolymer is known to be useful as a wood adhesive, wherein insecticide may be added. See, particularly, the abstract, and paragraph 27. Further, Metzner et al. teach that compositions consisting of adhesive and a biocide particularly against termites are known to be useful in wood products. See the abstract.

Therefore, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to modify the composition of HIRAIWA DAIKU by employing the specific compounds cited in the instant claims, e.g., fipronil as the insecticide and the specific resins cited in the instant claims as the adhesive resin.

A person of ordinary skill in the art would have been motivated to modify the composition of HIRAIWA DAIKU by employing the specific compounds cited in the instant claims, e.g., fipronil as the insecticide and the specific resins cited in the instant claims as the adhesive resin because pyrazole compounds including fipronil are known to be useful as insecticides against termites and compositions consisting of an adhesive and an insecticide particularly against termites are known to be useful in wood products. Further, all the resins employed in the instant claims are known to be useful as wood adhesives. The selection of a specific resin, e.g., ethylene-vinyl acetate copolymer, phenol-formaldehyde resin or resorcinol-formaldehyde resin is seen to be a selection from amongst equally suitable material and as such

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obvious, absent evidence to the contrary. Ex parte Winters 11 USPQ 2nd 1387 (at 1388).

Furthermore, wood based materials made with a composition suggested to be useful in wood based materials is considered within the skill of artisan.

6. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over HIRAIWA DAIKU (JP52127936, of record and Derwent publication abstract No. 77-872784, IDS of Jan. 29, 1999, BD) in view of Yoshitomi Pharm. (Derwent publication abstract No. 81-06781D, IDS of Jan. 29, 1999, BE), Yamauchi (JP-0517732), Kodama et al. (WO 95/22902, IDS of Jan. 29, 1999, AB) and Metzner et al. (DE3536417), for reasons discussed above, in further view of Jensen-Korte (US 4,945,165). DAIKU, Yoshitomi Pharm, Yamauchi, Kodama et al. and Metzner et al. together do not teach expressly the particular N-aryl Pyrazole derivative herein, which differ from fipronil in R1 (Methyl v. CN), R11 and R12 (H v Cl). However, Jensen-Kort et al. teaches N-aryl pyrazole insecticides encompassing the pyrozale herein, wherein the R1 may be hydrogen or C1-C4 alkyl, and the aryl group may be mono substituted phenyl group, and the substituent may be trifluoromethyl. See, particularly, column 1-4. The insecticides are known to have a wide spectrum of insecticidal activity against a variety of insects, including order isoptera, genus Reticulitermes. See, particularly, column 32, lines 32 to column 33, line 66.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ the pyrazole compounds herein as the pesticide in wood adhesive.

A person of ordinary skill in the art would have been motivated to employ the pyrazole compounds herein as the pesticide in wood adhesive because the compounds have a similar chemical structure as fipronil, and are known to be similarly useful against insect like termite.

Response to the Arguments

Applicants' remarks and the declaration under 37 C.F.R. 1.132 have been fully considered, but are not persuasive for reasons discussed below.

The declaration under 37 CFR 1.132 filed June 18, 2004 is insufficient to overcome the rejection of claims 1 and 17-39 based upon HIRAIWA DAIKU (JP52127936, of record and Derwent publication abstract No. 77-872784, IDS of Jan. 29, 1999, BD) in view of Yoshitomi Pharm. (Derwent publication abstract No. 81-06781D, IDS of Jan. 29, 1999, BE), Yamauchi (JP-0517732), Kodama et al. (WO 95/22902, IDS of Jan. 29, 1999, AB) and Metzner et al. (DE3536417) as set forth in the last Office action because: There is no evidence supporting the alleged unexpected and surprising benefit. Applicants may not simply assert an unexpected benefit residing in the claimed invention without providing factual support. Regarding the establishment of unexpected results, a few notable principles are well settled. It is applicant's burden to explain any proffered data and establish how any results therein should be taken to be unexpected and significant. See MPEP 716.02 (b). The claims must be commensurate in the scope with any evidence of unexpected results. See MPEP 716.02 (d). Further, A DECLARATION UNDER 37 CFR 1.132 *must compare* the claimed subject matter with the closest prior art in order to be effective to rebut a prima facie case of obviousness. See, MPEP 716.02 (e). Applicant provides neither data, no explanation as to illustrate how, and why the claimed invention would yield unexpected benefit. The scope as claimed does not commensurate with the alleged unexpected benefit. Finally, there is no comparison of the claimed invention with the prior art.

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7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion, or motivation is found both in the references and the knowledge generally available to one of ordinary skill in the art. Particularly, because pyrazole compounds including fipronil are known to be useful as insecticides against termites and compositions consisting of an adhesive and an insecticide particularly against termites are known to be useful in wood products.

8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. SHENGJUN WANG
PRIMARY EXAMINER